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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Extension of the Expression of Transgenic Proteins by Immunomodulation
Application No. 09/381,344 Art Unit 1632
Filed September 20, 1999 Examiner Shukla, R

PREPARATION OF SUPER ABSORBENT POLYMERS

(Attorney Docket No. P25,986 USA)

Certificate of Mailing

I certify that this document and fee is being deposited with the U.S. Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 12, 2003.


Phyllis Keith

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Request Under 37 CFR § 1.143 for Reconsideration and
Withdrawal of Requirement for Restriction Dated March 11, 2003

Sir:

In response to the Examiner's Action mailed March 11, 2003, applicants traverse hereby the Examiner's Requirement for Restriction set forth therein and request respectfully reconsideration and withdrawal of the Requirement.

The Examiner has required restriction between the following groups of

claims:

Group I. - Claims 1 and 4 to 18 which are directed to the method of expressing a transgenic product in a mammal; and

Group II. - Claims 19 to 22 which are directed to a method of screening for an immunosuppressant compound using a mammal.

The basis for the Examiner's Requirement for Restriction is that he considers the two groups of claims to define distinct inventions. The Examiner has required also that applicants restate the species election as set forth in the Office Action of April 1, 2001.

It is submitted respectfully that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires that the involved inventions be also independent. Clearly, the inventions defined in the claims of Groups I. and II. are not independent in that the claims in each of the groups relate to immunosuppressants for increasing tolerance of a mammal to transgenic cells. The Examiner has recognized apparently that the claim groups do not define independent inventions because he has not characterized them as being independent. Moreover, the Examiner has not even attempted in his Action to explain why he considers the claims to be directed to independent inventions. Consequently, the Examiner has issued a requirement that is deficient on its face because he has not explained why the two claim groups are considered to define independent subject matter. Accordingly, the Requirement should be withdrawn.

It is submitted further that the Examiner's Requirement should be withdrawn because it is believed that a proper search of the subject matter of either the Group

I. claims or the Group II. claims cannot be done except that a search be conducted for the subject matter of both groups of claims. This is so because the subject matter of the claims is so interrelated. For example, the Group II. claims are directed to a method for identifying a substance which has immunosuppressant properties and which remains capable of suppressing the immune response of a mammal to a transgenic cell after administration has been discontinued. The Group I. claims are directed to a method for increasing the tolerance of a mammal to transgenic cells and to a method for expressing a transgenic product in a mammal.

It is submitted further that the Examiner's Requirement for election of a hereditary disorder from Claims 7, 14 and 15 is contrary to the requirements set forth in PCT Rules 13.1 and 13.2. Tolerance to gene therapy is improved for all of the disorders listed in Claim 7 regardless of the particular disease undergoing treatment. Thus, the invention involves a general inventive concept in compliance with PCT Rule 13.1. The Examiner's failure to consider the overall intended effect of the invention in the treatment of the disorders listed in Claim 7 is in error, and the election of species requirement should be withdrawn.

Applicants elect provisionally to prosecute in this application the claims of Group I., that is, Claims 1 and 4 to 18. As requested by the Examiner in the Requirement, applicants provisionally elect, as the single disclosed species, p15-deoxyspergualin (DSG), listed on page 1, line 35 through page 2, line 1, and on page 2, line 35 of the specification. Pursuant to 37 C.F.R. §1.146, upon the elected species being found allowable, the Examiner should continue to examine the full scope of the claimed subject matter by extending the search to the non-elected species as required under M.P.E.P. Section 803.02 and 35 U.S.C. §121. Finally, applicants elect provisionally to prosecute in this application osteoarthritis from the list of hereditary disorders in Claim 7.

Docket No. P25,986 USA

Application No. 09/381,344

Enclosed in duplicate is a Petition for Extension of Time Under 37 CFR § 1.136(a) requesting an extension of time to respond to the Examiner's Action for a period of one month.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Jane E. Alexander", written in dark ink.

Jane E. Alexander

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